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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO <i>T.D.</i>
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

*5*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/436,520

Applicant(s)

CHANG ET AL.

Examiner

Christina Ildebrando

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsao.

Tsao (US 5,384,296) discloses a catalyst composition useful in isomerization processes. The catalyst composition contains a zeolite such as MCM-22 (column 3, line 7 and column 4, lines 30-35). Tsao teaches that the catalyst contains noble metal components selected from group VIII, including ruthenium, as hydrogenation components, and a non-noble metal, including zinc, cobalt, and nickel, as promoters (column 4, lines 9-30).

3. Claims 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Del Rossi et al.

Del Rossi et al. (US 5,108,969) discloses a catalyst composition useful in hydrocarbon conversion processes. The reference teaches and claims an MCM-22 zeolite having a group VIII metal and tin thereon (column 8, lines 37-46 and claim 1).

The reference does not specifically teach the metal ruthenium but instead teaches the use of Group VIII metals. It has been held that when the compound is not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various substituents from a list of alternatives

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given for placement at specific sites on a generic chemical formula to arrive at a specific composition, anticipation can only be found if the classes of substituents are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). If one of ordinary skill in the art is able to "at once envisage" the specific compound within the generic chemical formula, the compound is anticipated. One of ordinary skill in the art must be able to draw the structural formula or write the name of each of the compounds included in the generic formula before any of the compounds can be "at once envisaged." Refer also to *In re Schauman*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978) and MPEP 2131.02.

It is the position of the examiner that the teachings of the reference are drawn to a class of metals sufficiently limited to constitute anticipation. It is considered that one of ordinary skill would have been able to at once envision ruthenium as a group VIII metal taught by the reference.

#### ***Response to Arguments***

4. Applicant's arguments filed 3/20/01 have been fully considered but they are not persuasive.

With regards to the rejection over Del Rossi et al., applicant argues that to constitute anticipation, a reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking and choosing.

However, as discussed above, it is the position of the examiner that the teachings of Del Rossi et al. would direct those skilled in the art to the compound

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instantly claimed without any need for picking and choosing. The reference teaches the generic group, "group VIII metals," of which there are only 9. One of ordinary skill would be able to at once envision the group VIII metals, including ruthenium, from the teachings of the reference. While Del Rossi et al. might prefer different metals than those instantly claimed, a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

Applicant's arguments that to would not have been obvious to arrive at the invention instantly claimed have been considered but do not appear to be pertinent as the claims have been rejected under 35 USC 102 and not 35 USC 103.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Huang (US 5,705,729) discloses a catalyst composition containing a zeolite such as MCM-22, MCM-36, MCM-49, or MCM-56 and one or more hydrogenating components. Refer to columns 3-10.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina Ildebrando whose telephone number is (703) 305-0469. The examiner can normally be reached on Monday-Friday, 7:30-5, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6078 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

CAI  
May 2, 2001

  
STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700